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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,081	03/06/2002	Richard P. Szajewski	81246ACPK	1514

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EXAMINER	
CHEA, THORL	
ART UNIT	PAPER NUMBER
1752	5

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,081	SZAJEWSKI, RICHARD P.	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15 and 27-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 27-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> **The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

Claims 1-15, 27-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to provide support for the newly amended presented in the version marking to show changes made in claims 1, 2, 7, 27, 28. Note especially the language "instead of" wherein the specification as originally filed fails to provide support thereof or the use thereof to exclude the colored dye-forming coupler from dye form the image recording units. Therefore, the language raises new concept that was not been presented at the time of filing.

The applicants' argument with respect to the basis of term "instead of" is not persuasive. The languages are not directed to the use of the infrared dye forming coupler for recording blue, green, or red exposure instead of (in place of) a colored dye-forming coupler, but not the shifting of color hue of magenta, cyan or yellow dye forming by the magenta, cyan, or yellow coupler to infrared region such as shown in the specification such as Table 2 on page 70. The language in the specification, page 1, line 11-14, discloses "the present invention comprises record shifting by means by

employing one infrared dye in color unit in the film, thereby forming one image record in the infrared region". This language fails to provide support for the infrared dye-forming coupler for recording the blue, green or red exposure, but "image record in the infrared region".

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language in claim 1 "(w)herein at least one image recording layer in the image recording layer units comprises an infrared dye-forming coupler instead of a colored dye-forming coupler for recording the blue, green or red exposure" is unclear as to what couplers for recording the blue, green or red exposure, i.e. infrared dye-forming coupler or colored dye forming coupler.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim R j ctions - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

6. Claims 1-7, 11-14, 27-29 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP4-86658 (JP'658). JP'658 discloses a heat developable color photosensitive material containing a dye providing substance and an infrared dye forming coupler. On page 556, first column line 19, it is discloses the use of the infrared dye forming coupler in a photosensitive silver halide layer containing a cyan dye; the use of a color developing agent such as paraphenylene compound is shown on page 565, second column; the heat developable color photosensitive material containing yellow, magenta and cyan coupler is shown in Table 2 on page 567. The JP'568 discloses therefore the use of an infrared dye forming coupler and a paraphenylene diamine type in a cyan coloring layer of a heat developable within the meaning at least one image recording layer in the recording layer units within the scope of claim 1 of the present claimed invention. Therefore, JP'658 anticipates the claimed invention. Alternatively, it would have been prima facie obvious to the skill of ordinary skill in the art to use the infrared dye-forming layer taught in JP'658 such as suggested therein to provide a material as claimed. The invention in claim 8 is related to the use of hue-shifting developing agent thereof. This developing agent is similar type of that taught in the JP'658 discussed above. The property such

as hue-shifthing due to the developing agent or precursor thereof is inherent to the of infrared dye and the paraphenylene diamine type developing agent taught in the JP'658. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious over JP'658.

7. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato as applied to claims 1-7, 11-14 above, and further in view of Bohan et al ('470) Bohan in column 11 discloses that overall, the limited Dmin and tone scale density enabled by controlling the quantity of incorporated masking coupler, incorporated permanent Dmin adjusting dyes and support optical density can both limit scanning noise and to improve the overall signal-to-noise characteristic of the film to be scanned. It would have been obvious to include the color masking coupler, permanent Dmin adjusting dyes and the optical density in the material of Kato to limit scanning noise and improve the overall signal-to-noise characteristic of the film to be scanned.

8. Claims 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishikawa et al (Ishikawa).

Ishikawa discloses a color photographic material containing a paraphenylene diamine compound similar to that of the present claimed invention. See especially samples 2-3 in column 16, developer compound A, and column 19, claim 1, formula (I). Ishikawa may not disclose the term "hue-shifting" such as presented in the present claimed invention; but the developer use therein has similar functional group. Accordingly, the property such as "hue-shifting" is inherent to the dye of Ishikawa. The absence of

showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious over Ishikawa.

Response to Arguments

9. Applicant's arguments filed February 10, 2003 have been fully considered but they are not persuasive.

The applicants argue that "the present element comprises an element that, on development, comprises essentially only three basic dyes, one of which is an infrared dye. Thus, it is possible, for example in one embodiment, to use two colored dyes and infrared dye or, in another embodiment, one colored dye and two infrared dye, but not three color dye as in JP'658. In contrast to the present invention, JP'658 forms an infrared dye in addition to cyan, magenta, and yellow. The infrared dye is not taking the place of one of the three colored images.

The argument is not persuasive. The image recording units present in the claimed invention contains one or more image recording layer. Note for instance to the specification on page 3 second paragraphs which discloses that "(a) coloring layer unit ("unit" or "color unit ") can comprise one or more imaging layers". The claimed invention is directed to the use of the infrared dye-forming coupler in at least one of image recording layer in the image-recording units. The scope of the claims encompasses the use of colored dye-forming coupler in any other layer, or limit the claims to the three basic dyes presented in the argument, and there is no clear distinction between the claimed invention in view of the teaching of JP'568.

image recording unit.

The argument with respect to Ishikawa is not persuasive since the developer D2 is not include in the claims, and the scope of the colored dye forming coupler and the developer claimed in the present invention is within the scope those taught in Ishikawa. See the generic compound taught in Ishikawa in the abstract wherein R3-R6 include an alkyl group.

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-15, 27-29 are are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15, 27-28 of copending Application No. 09/855,046. This is a provisional double patenting rejection.

The rejection is maintained as being held non responsive to the first office action.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea
April 19, 2003

Thorl Chea
Primary Examiner
Art Unit 1752